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EXAMINER

PIERCE, WILLIAM M

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3711

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 10

Application Number: 09/884,518
Filing Date: June 19, 2001
Appellant(s): LUEBKE, THOMAS M.

Terri Flynn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/21/03.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

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(4) Status of Amendments After Final

The amendment after final rejection in the form of a Declaration of David Huebschen filed on 7/21/03 has not been entered. No other amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The examiner has not sustained the rejection of claim 11 under Hubscher. The issues remains whether claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubscher.

(7) Grouping of Claims

The rejection of claims 1-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,023,159	Heger	2-2000
4,797,040	Hibbard	1-1989

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubscher.

As to claim 1, shown is a housing 11 with a flat surface 15, an attachment member 31, sensing circuitry in fig 5 and indicator 75. The housing is considered "shaped to provide a handrest" as called for in claim 2 by allowing an operators hand to rest at reference number 11 in fig. 1. The flat surface 15 interfaces with the drill as called for in

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claim 3 since the broadest definition of "interface" is to "interact smoothly". The attachment member 31 is considered to be adjacent or "next to" the flat surface 15 as called for in claims 4 and 5. As to claim 6, the attachment member includes a key hole 20 with an enlarged area 25 and narrow area 35.

As to claim 1, Appellant has argued that examiner's interpretation of element 15 as being "flat" is incorrect. Examiner's interpretation is based on the section view of Hubscher's fig. 1. Fig. 2 does nothing to define surface 15 as anything other than "flat" since it merely shows a cross-section taken along II-II of fig. 1. The functional limitations of "for use with a drill" and "for probing across a wall surface" fail to distinguish over the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Hubscher clearly shows an "accessory" as called for in claim 1. The intended use for it to be slid across the wall or for use with a drill do not distinguish the claim from the applied art. To the extent that applicant's arguments infer that Hubscher is not "capable" of being slide across a wall is inconclusive. Portion 15 can be slid across a wall at a distance out of contact with the wall. Even if the claim were amended to recite the implication that the surface is in contact with the wall, such would not distinguish over Hubscher since other surfaces of the housing 15, such as that in the area of reference 55 as shown in fig. 1, are capable of sliding along a wall while in contact therewith.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbard and further in view of Heger.

Hibbard shows a drill with a holding system for holding paraphernalia needed for a particular job. Known in drilling holes is the use of a stud sensor for determining the location of a stud prior to drilling a hole in a wall. To have combined a drill with a detachable stud sensor would have been obvious in order to make it more convenient. The location and the means for mounting the sensor to the drill is considered an obvious matter of design choice. Each device operates independently as expected and the combination of the two does not solve any particular problem or

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produce any unexpected results. It is noted that case law has held that a designer skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

As to Hibbard and Heger, applicant's argues against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Subsurface locators are known to be used in combination when drilling into a wall. This is the intended purpose of such devices. Such a teaching is clearly not from applicant's disclosure. Hibbard shows attaching accessories used in combination with a drill to its housing. Heger teaches what is known as discussed above, that surface locators used in combination with drills are known. The examiner has extensive personal experience with both a stud finder and a drill in applications such as installing wall anchors for shelves. The use of these tools together in combination as being known to the prior art has little room for argument. . Further one must consider such is a matter of common knowledge and common sense of the person of ordinary skill in the art to design a table that is bigger where more room is needed. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962).

The argument that a subsurface object locator would have "difficulty in mounting to a drill" is unpersuasive. One skilled in the art would clearly be able to determine shapes necessary to attach two devices in a compatible way. Note that skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Applicant alleges that he has solved a problem with interference between the drill and the subsurface locator (i.e. the electric motor interfering with the electronics of the locator). However, this recitation on pg. 6 only refers to the addition of plates 75 and 71 only to the subsurface locator. This design has nothing to do with the combination of the subsurface locator with the drill. Moreover, in applicant's invention each device is to be detached and used separately as they were intended. No interference would occur between each device since they are to be used separately.

New claims 12-16 calls for the design of the attachment means. Where Hibbard shows the use of Velcro, it is clear that other know removably attaching means are known. To have chosen an alternate design to attach the drill in accessory would have been an obvious matter of replacing one known expedient for that of another. As set

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forth above, skill presumed by those in the art. Applicant has not shown where his attachment choice solves any particular problem or produces any unexpected results.

(11) Response to Argument

A. With respect to claims 1-6 and 11, Hubscher shows each and every limitation of the claim as set forth in the grounds for rejection above.

I. Applicant's analysis of the prior art is noted.

II. As to claim 1, it calls for a "object locating accessory" for use with a hand drill. According to the limitations of claim 1, the "accessory" merely requires a housing having a flat surface. This housing is shown by 11 and has a flat surface 15. As further called for it has "an attachment member" in the socket 31 which is indeed capable of performing the function of attaching it to a "drill housing" as shown in fig. 1 and where the drill housing is outlined by a dashed line. A sensing circuitry as called for by the claim is shown in fig. 5 and an object indicator is shown by 70. Appellant argues first that the examiner's interpretation of element 15 as being "flat" is flawed since figs. 2 and 3 show the end to be "round". One must consider the evidence submitted by the examiner and note that a preponderance of the evidence exists when it suggests that it is more likely than not that the assertion in question is true. *Herman v. Huddleston*, 459 U.S. 375, 390 (1983). In this case Hubscher shows a cross-section which is "flat" at least in the vertical direction. If the surface was that of a pyramid, spherical or the like, then such a surface profile would show in his cross section of fig. 1. In addition to this overwhelming suggestion of the evidence of record, one must presume skill on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). In doing such, one would note that the "accessory" of Hubscher is designed to be used by working to cut holes in a flat wall. A protruding surface at 15 on his accessory would only interfere in the operation of such a device.

Furthermore, appellant presupposes that even if 15 were flat then it could not be slid across a wall. First, such an argument assumes that the "accessory" is required to be in contact with the wall. However, the claim does not positively require such intended use. Secondly, such a limitation is only functional and does not distinguish over the prior art. Well settled is that an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Lastly, it has to be assumed that the surface 15 of Hubscher does not "slide across the wall" while a hole is being cut. It would have to be assumed that one couldn't place surface 15 on wall adjacent to a corner where the blade 65 would pass around the corner of the wall to allow the surface 15 to slide along the wall. Since the prior art structure is capable of performing

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the intended use set forth in the claims as shown by the examples set forth above, then it is submitted that it meets the claim as held in *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Next, appellant offers to the Board that the bore 31 of Hubscher, "is not an attachment member". Yet the claim offers no other structure other than the functional recitation, "for detachably mounting the accessory housing to the drill housing." Even if one were to give weight to the functional recitation, it is considered met by Hubscher as shown in fig. 2 by the dashed outline of a drill housing for mounting the accessory.

Appellant's remarks with respect to claim 11 and Hubscher are moot since examiner has not sustained this grounds for rejection for the purposes of appeal.

III. As shown above, Hubscher can be construed to met each and every limitation of the claimed invention and the rejection of claims 1-6 under 35 USC 102(b) should be affirmed. The appellants arguments have not pointed to any clear flaw in the reasoning of the examiner, nor have they pointed to any evidence of record indicating that the findings of the examiner are unsupportable. Merely he offers an alternative interpretation of the prior art. The board should give deference to the examiner's determination of obviousness as held in *In re Berg*, 65 USPQ2d 2003 (Fed. Cir. 2003).

B. Appellant's case citations on pg. 6 are noted. However, since appellant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references, no further comment is deemed necessary.

I. and II. Admitted by the examiner in this grounds for rejection are the lack of the means for mounting the stud sensor to the drill. The question here, however, is not meeting the terms of the claims. The rejection is for obviousness of what is claimed, which involves consideration of the ordinary skill of the art. As for resulting in a useful device, appellants are talking about attaching a known device such as a stud sensor to a drill housing. They are assuming that one of ordinary skill would not appreciate the applied art and numerous citations of art made that shows attaching tools that are used with a drill to the drill housing for storage and organizational purposes. Surely appellant is not the inventor of flat surfaces on drills. One would have to only consider the prior art such as Lee '458 to come to this conclusion. If one skilled in the art were considering attaching a known stud sensor (which commonly have flat surfaces) to a drill, surely he would consider designing the drill to have a surface that cooperates with that of the stud sensor. Likewise, the appellant is not the inventor of a slot and detent type attaching means. Surely one would consider all all known methods of attaching one

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tool to another. Not considering such would presume stupidity of those skilled in the art rather than skill. See *In re Sovish*, 226 USPQ 771, 769 F2d 738.

In order to sustain this rejection under obviousness, one must consider unexpected results and problems solved. In the instant case, there is nothing of record to show either. Each device still functions as they did separately. The attachment means does nothing to improve either device nor is there a synergistic effect that produces any unexpected results.

III. While appellant's position here is not quite clear, he appears to argue that the prior art does not appreciate the combined use of both a drill and a stud sensor together while doing construction. Once again this would presume that those drilling holes in walls while doing construction are stupid and would not consider what is behind the wall and what they may be drilling into. By their very nature, one use for a stud sensor is for locating studs behind walls so that one may drive a nail into the stud to hold a shelf or a picture. As disclosed by Hubscher, sensors in drilling holes in the wall are useful to locate metal electrical boxes. Hence, viewing the art as a whole provides ample suggestion to use both a drill and a stud sensor during construction tasks.

IV. Appellant formulates this next argument upon the presumption that "when applying standards of 'common sense' and 'personal experience', the principle evidence for the rejection must be found within the references". Clearly such is not true. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a prima facie obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flathead screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flathead screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not "motivate" use of Phillips head screws in place of flathead screws. What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a §103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art that would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination


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that was made by the applicant); *In re Gartside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778(Fed. Cir. 2000). In the instant case, it is known in the prior art to use both drills and stud finders together during construction, to attach tools used when drilling to the housing of the drill, to provide cooperating and compatible surface between devices that are attached together and to use a slot and detent type elements to removably attach devices together.

V. No evidence of non-obviousness exists in the record. As such this issue is moot. While applicant provides an affidavit accompanying his Brief, this has not been entered by the examiner for the purposes of this appeal. An advisory action reflecting the status of this affidavit has been completed concurrent with this Answer and made of record. Note that a new amendment, new affidavit, or other new evidence must be submitted in a paper separate from the appeal brief and that entry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right. See MPEP 1207. The entry of an amendment (which may or may not include a new affidavit, declaration, or exhibit) submitted in an application on appeal continues to be governed by 37 CFR 1.116, and the entry of a new affidavit or other new evidence in an application on appeal is governed by 37 CFR 1.195. Since the examiners must respond to all nonentered amendments after final rejection, and indicate the status of each claim of record or proposed an advisory action pertaining to the mentioned affidavit has been issued as mentioned above.

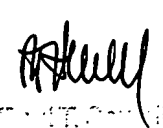
For the above reasons, it is believed that the rejections should be sustained.

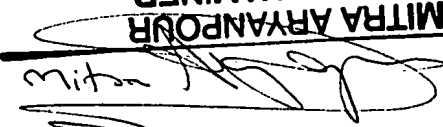
Respectfully submitted,


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October 6, 2003

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